

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. Reconsideration of the subject patent application in view of the present remarks is respectfully requested.

Claim Rejections - 35 USC § 112

Claims 1-3, 5, 6, 8-11, 14-24, 26, and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully request withdrawal of the rejection for at least the following reasons.

The Office action states that the additional language disclosing “no additional water tight layer or layers are covering the outer protective sheath” does not appear in the specification and is believed to be new matter. However, support for the above additional language is found on page 4, lines 23-27 of the present specification which states:

In one embodiment no additional water tight layer or layers is applied between the armour layer and the outer protective sheath or covering the outer protective sheath, whereby the aggressive gases which are capable of diffusing out through the inner liner are not accumulated in the volume around the armouring profiles.

The term “no additional water tight layer or layers is applied between the armour layer and the outer protective sheath or covering the outer protective sheath” includes two variations
1) no additional water tight layer or layers is/are applied between the armour layer and the outer

protective sheath or 2) no additional water tight layer or layers is/are covering the outer protective sheath.

Accordingly, the feature “no additional water tight layer or layers are covering the outer protective sheath” is fully supported in the description and therefore the written description requirement is fulfilled.

Claim Rejections - 35 USC § 103

Claims 1-3, 5, 6, 8-11, 14-24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glejbol (559) in view of Greco, De Ganahl and Braad. Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Regarding claim 1, Greco is not combinable with Glejbol for obviousness inquiry, because Greco teaches away from Glejbol. According to MPEP §2145, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Here, Greco discloses that the reinforcement (12) is covered by an outer cover (14) which is an extruded layer (col. 2, lines 40-45 and col. 4, lines 3-9) which has high resistance to external influences (col. 1, lines 12-14) and is **impervious** (col. 3, lines 35-41). This disclosure indicates that the outer cover (14) must be impervious in order to have high resistance to external influences. On the other hand, Glejbol discloses that an outer layer (11) can be applied outermost on the pipe and this outer layer is **easily permeated** by the surrounding environment (paragraph [0054]). Greco, which requires that the outer cover (14) be impervious, clearly teaches away from Glejbol which uses the outer layer (11) easily permeated by the surrounding environment. A skilled person, who considered combining the teachings of Greco and Glejbol, would immediately understand that the teachings

of these two documents are clearly incompatible. If combining essential features of Greco with the pipe of Glejbol, the outer cover would no longer be permeable and accordingly the teaching of Greco goes strictly against the teaching of Glejbol, in which it is essential that an optional outer cover is highly permeable. Thus, Greco is not combinable with Glejbol for obviousness inquiry.

Also, there is no reason to combine Greco with Glejbol. Although KSR rejected a rigid TSM test for obviousness inquiry, KSR still requires a reason to combine the references. *KSR International, Co. v. Teleflex Inc.*, 550 U.S. 398. The reason to combine exists where there are a finite number of identified, predictable solutions with a reasonable expectation of success. According to MPEP §2143.02, evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Since Greco requires that the outer cover (14) be impervious and Glejbol uses the outer layer (11) easily permeated by the surrounding environment, a person skilled in the art would not have a reasonable expectation of success for applying the outer cover (14) of Greco to the outer layer (11) of Glejbol. There is no clear way of combining any features of Greco with the features of Glejbol, and furthermore a skilled person would not have any reason to perform any combination of features from these two documents and neither would he have any expectations of success that anything could be achieved by such a combinations. A skilled person would simply not know which feature to combine and for which reason and he would not have any expectation of achieving anything by such a combination. Thus, there is no reason for a person of ordinary skill to modify the outer layer (11) of Glejbol with the outer cover (14) of Greco.

Moreover, there is no suggestion or motivation to combine Greco with Glejbol because combining Greco with Glejbol would render the Greco's invention unsatisfactory for its intended purpose. According to MPEP §2143.01, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, if the outer cover (14) of Greco is modified by the outer layer (11) of Glejbol which is easily permeated by the surrounding environment, the resulting pipe would be unsatisfactory for the intended purpose of Greco which is to provide high resistance to external influences. Even if a skilled person tried to modify the pipe of Glejbol based on the teaching of Greco, he would not end up with a pipe according to the present invention, because it is an essential feature and in fact the whole idea of Greco that the hose should have an impermeable outer cover bonded to an underlying reinforcement. Thus, there is no suggestion or motivation to combine Greco with Glejbol.

Therefore, the asserted combination of Glejbol, Greco, De Ganahl and Braad does not render claim 1 obvious. Thus, withdrawal of the rejection as it applies to claim 1 is respectfully requested.

Claims 2-3, 5, 6, 8-11, 14-24, 26, and 27 which are directly or indirectly dependent from claim 1 should be allowable for at least the same reason as claim 1.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. NKTR-46756.

Respectfully submitted,

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